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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/872,008
Filing Date: June 04, 2001
Appellant(s): TESHIMA, ATSUSHI

MAILED

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Technology Center 2600

John J. Dresch, Reg. No. 46,672
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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 19th 2005 appealing from the Office action mailed January 25th 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 3, 8 and 10-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee.

B. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 3, 8, 10 and 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,658,167 to Lee et al.

8. With regard to claim 3, Lee discloses an image registration system comprising a first client device and a second client device which can communicate with a server (Fig. 1).

Lee further discloses wherein said first client device (Fig. 1, element 110a) comprises first image data transmission means for transmitting to said server image data to be registered, and

the server (Fig.1, element 100) comprises image data receiving means for receiving the image data transmitted from said first image data transmission means in said first client device,

image data generation means for generating image data representing the same image as an image represented by the image data received by said image data receiving means and having a different form of representation therefrom (column 2, lines 32-47 and Fig.2, element 220), and

image data storage means for storing the image data generated by said image data generation means so as to be accessible from the second client device (column 2, lines 32-47).

Lee discloses a system where data or digital images are transmitted to a server and modified according to optimization for preferred use. The server optimizes the data or generates new image data and inherently stores the data for use by the client.

Lee further discloses wherein said second client device (Fig. 1, element 110b) comprises request data transmission means for transmitting to said server request data representing a request to transmit the image data stored in said image data storage means (Fig. 2, element 210), and the server (Fig. 1, element 100) comprises request data receiving means for receiving the request data transmitted from the

request data transmission means in the second client device (Fig. 2, element 210), and

image data retrieval means responsive to the request data received by said request data receiving means for finding from the image data storage means the image data suitable for image output by the second client device which has transmitted said request data out of the image data stored in the image data storage means in the server (Fig.2, element 210), and

second image data transmission means for transmitting to the second client device the image data found by said image data retrieval means (column 3, lines 30-40 and Fig.2, element 230). Lee discloses several clients connected to the server capable of transferring and requesting image data that would inherently be called from image storage in the server. In order to transfer data in a networked environment it is inherent that both the server and clients are able to receive requests to transfer data. This is known as handshaking and is necessary to transfer data.

9. With regard to claim 8, Lee discloses an image transmission server which can communicate with a client device, comprising:

image data generation means for generating image data representing an image which can be outputted to the client device and

representing the same image as an image represented by fed image data and having a different form of representation therefrom (Fig.2, element 220);

image data storage means for storing the image data generated by said image data generation means so as to be accessible from the client device (Fig.2, element 220);

request data receiving means for receiving request data representing a request to transmit the image data stored in said storage means (Fig 2, element 210);

image data retrieval means responsive to the request data received by said request data receiving means for finding from the storage means the image data suitable for image output by the client device which has transmitted the request data out of the image data stored in the storage means in the server(Fig. 2, element 220); and

image data transmission means (Fig.2, element 230) for transmitting to the client device the image data found by said image data retrieval means (column 2, lines 32-47 and column 3, lines 42-50). Lee discloses a system that modifies image data to a different form or representation in a server and then transmits the new image data to the client for use. The features of image data storage means, request data receiving means, image data retrieval means, and image data transmission means are all inherent to a network system. In order to

transfer data in a networked environment it is inherent that both the server and clients are able to receive requests to transfer data. This is known as handshaking and is necessary to transfer data.

10. With regard to claim 10, Lee discloses an image transmission server, which can communicate with a client device, an image transmitting method comprising:

generating image data representing an image which can be outputted to the client device and representing the same image as an image represented by fed image data and including a different form of representation (Fig. 2, element 220);

storing the generated image data so as to be accessible from the client device;

receiving request data representing a request to transmit the stored image data (Fig. 2, element 210);

finding the image data suitable for image output to the client device which has transmitted the request data out of the stored image data in response to the receiving request data(Fig. 2, element 220); and

transmitting to the client device the found image data (Fig. 2, element 230 and column 2, lines 32-47 and column 3, lines 42-50).

Lee discloses a system that modifies image data to a different form or representation in a server and then transmits the new image data to the

client for use. The features of storing the generated image data, receiving request data, finding the image data, and transmitting the image data are all inherent to a network system. In order to transfer data in a networked environment it is inherent that both the server and clients are able to receive requests to transfer data. This is known as handshaking and is necessary to transfer data.

11. With regard to claim 11, Lee discloses an image registration system comprising:

a first client device (Fig. 1, element 110a);

a second client device (Fig. 1, element 110b); and

a server in communication with at least one of said first client device and said second client device (Fig. 1, element 100),

wherein said server comprises:

image data receiving means for receiving image data transmitted from said first client device,

image data generation means for generating image data suitable for output to said second client device and representing a same image as an image represented by said image data from said first client device received by said image data receiving means and including a different form of representation therefrom (column 2, lines 32-47 and Fig.2, element 220);

image data storage means for storing said image data generated by said image data generation means, wherein said image data is accessible from the second client device (column 2, lines 32-47);

request data receiving means for receiving request data transmitted from said second client device (column 3, lines 30-40 and Fig.2, element 230); and

image data retrieval means responsive to said request data from said second client device, for retrieving said image data suitable for output to said second client device from the image data stored in the image data storage means (Fig.2, element 210).

Lee discloses several clients connected to the server capable of transferring and requesting image data that would inherently be called from image storage in the server. In order to transfer data in a networked environment it is inherent that both the server and clients are able to receive requests to transfer data and that data must be inherently retrieved or called from some form of storage. This is known as handshaking and is necessary to transfer data.

12. With regard to claim 12, Lee discloses second image data transmission means for transmitting to the second client device the image data retrieved by said image data retrieval means (column 3, lines 30-40 and Fig.2, element 230). Lee discloses several clients connected to the

server capable of transferring and requesting image data that would inherently be called from image storage in the server. In order to transfer data in a networked environment it is inherent that both the server and clients are able to receive requests to transfer data. It is also inherent that data be retrieved or called from memory or storage. This is known as handshaking and is necessary to transfer data.

13. With regard to claim 13, Lee discloses the image registration system according to claim 11, wherein said image data retrieval means retrieves, from the image data storage means, said image data suitable for output to the second client device from the image data which is previously generated and stored in the image data storage means (Fig. 2). Lee discloses image data transferred to a server where it is inherently stored modified and inherently stored again and transmitting modified image data to another client application which must inherently request the data in a forma of handshaking to be transmitted over a networked connection. The data to be transferred must be inherently retrieved from memory in some way and transferred.

14. With regard to claim 14, Lee discloses the image registration system according to claim 13, wherein said second image data transmission means transmits to the second client device the previously

generated and stored image data found by said image data retrieval means (Fig. 2).

15. With regard to claim 15, the discussion of claims 13 applies.

16. With regard to claim 16, the discussion of claim 3 applies.

17. With regard to claim 17, the discussion of claim 13 applies.

18. With regard to claim 18, the discussion of claim 10 applies. The data must inherently be stored prior to receiving request data. It is digital data that must reside in some form of memory.

19. With regard to claim 19, the discussion of claim 10 applies.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,658,167 to Lee et al.

21. With regard to claim 4, Lee discloses the image registration system according to claim 3 (Fig. 1). Lee does not disclose a number-of-requests counting means for incrementing the number of transmission requests issued by said second client device. It is well known in the art that requests for data transfer must be acknowledged in a handshaking method to exchange information. Examiner takes official notice. Those requests are inherently counted and acknowledged as they are received. Therefore it would have been obvious to one of ordinary skill in the art to use a number-of-requests counting means in order to acknowledge when and how many requests are received by the server and to transfer data accordingly.

22. With regard to claim 5, Lee discloses the image registration system according to claim 3, wherein said server comprises a first server (Fig. 1). Lee does not disclose explicitly a second server, however he does disclose the use of the Internet. It is well known in the art that the Internet or any kind of computer network contains many servers that can communicate with one another. Examiner takes official notice. Therefore it would have been obvious to one of ordinary skill in the art at the time of

invention to use multiple servers and clients in operation in the same way as the first server and client.

23. With regard to claim 6, Lee discloses the image registration system according to claim 3, wherein said server comprising a first (Fig. 1). Lee does not disclose explicitly a second server, however he does disclose the use of the Internet. It is well known in the art that the Internet or any kind of computer network contains many servers that can communicate with one another. Examiner takes official notice. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use multiple servers and clients in operation in the same way as the first server and client.

(10) Response to Argument

Response to Appellant's Argument

i) Appellant argues that Examiner's claim interpretation is unreasonably broad and fails to consider the claimed invention as a whole. Appellant argues that the Lee does not disclose wherein that the image data is previously generated and stored. Examiner points out that the "previously generated and stored" language does not appear in the independent claims. It appears later in the dependent claims but the language is not in independent claim 3. Examiner further points out that when image

data is optimized or modified as taught by Lee (column 3, lines 32-50, column 4, lines 1-15 and column 5, lines 1-25) are previously generated and stored in the sense that they must be generated and stored or reside somewhere in memory before or even during transferring. Lee teaches that the image data is modified at the server and then transmitted only after being generated in optimized form (column 5, lines 10-35 and column 3, lines 51-67). In the case of Lee, where it is disclosed that operations are performed on the fly or each time a request is made, the image data must inherently be stored in a memory in order for the enhanced, optimized or modified image to exist in digital from at all. If the modified digital image is not stored, then where in cyberspace does it reside? Storage of the modified image is inherent to the existence of modified image data to be sent over a network connection.

ii) Appellant argues that Examiner's claim interpretation is unreasonably broad and fails to consider the actual language of the claims. Appellant argues further the language of "previously generated and stored" limitation. The discussion above applies. Lee discloses that the image data is previously generated and stored. It should be clear that this is not a novel feature and does not limit the claim in a meaningful way. The image data must be inherently generated and stored somewhere in a digital memory before it can be transferred or read or used in any way.

iii) Appellant argues that "Handshaking" is not germane to the claimed invention. Appellant argues that Examiner has clearly not considered all of the actual claim language and has mischaracterized the features of the claims as being comparable to "handshaking." In response, Examiner stands by the example of

handshaking as the required way in which networked devices communicate and appreciates the definition cited by the Applicant. Applicant further states that handshaking has nothing to do with the novel and unobvious features of the claimed invention. Examiner would like to know exactly what applicant believes to be the novel and unobvious features of the claimed invention. When there is communication between client and server devices in a networked system, requests for data to be sent are commonplace and in most cases required in order for a transfer to occur. For example Lee discloses a client device sending the server a request for image data and specifically client preferences fro processing the image data (column 3, lines 51-67 and column 4, lines 1-16). This is how client and server devices communicate. It is not novel and certainly not unobvious.

iii (2) Appellant argues that Claims 3, 8 and 10-19 are not anticipated by Lee. Once again appellant is reliant on language that does not actually appear in the independent claims. The term previously generated image data does not appear in the independent claims, yet Appellant repeatedly argues that the image transmission server finds the previously generated image data suitable for the output of the output device in the client device. The discussion presented above applies. Examiner points out that when image data is optimized or modified as taught by Lee (column 3, lines 32-50, column 4, lines 1-15 and column 5, lines 1-25) are previously generated and stored in the sense that they must be generated and stored or reside somewhere in memory before or even during transferring. Even in the case of Lee where it is disclosed that operations are performed on the fly or each time a request is made, the image data

must inherently be stored in a memory in order for the enhanced, optimized or modified image to exist in digital from at all. If the modified digital image is not stored, then where in cyberspace does it reside? Storage of the modified image is inherent to the existence of modified image data to be sent over a network connection. Furthermore previously generating the data for storage is inherent to occur before sending the modified image data. How can the modified image data be sent from the server without being first generated and stored? The data must be previously generated at some point before sending the generated image data in the embodiment of Lee.

Furthermore, Examiner stands by the discussion presented in the Advisory action presented here fro convenience of the board.

Applicant argues that the reference of Lee does not disclose several features of the present claimed invention. Applicant argues that the Examiner has not considered the language of the claims and that the Examiner has merely generalized the features of the claims as "handshaking." Examiner submits that only the language of the claims has been considered. The specification is not read into the claims and as the claims read on their own, they read on the exceedingly well-known practice of "handshaking." Applicant further argues the differences between the reference of Lee and the present claimed invention with such features as "previously generated" image data for transmisiion and argues that Lee discloses processing data "each time" the access is made to the server. However Examiner submits that this distinguishing feature does not appear in the claims. Examiner submits that the reference of Lee discloses all of these

features either explicitly or inherently. Applicant further argues that the cited reference of Lee in column 3, lines 34-37 discloses that the processing for modifying data is performed in the server computer "each time" access is made by the client computer, in contrast to the present invention which Applicant argues "previously is generated" (which language is not claimed). Examiner submits that Lee states that the intended use of the information is made known by communiction of the first client (not the second client) with the server and that processing is performed according to intended use (for either later or immedeate) transmission (column 3, lines 34-37). Examiner submits that this reads on the present invention as claimed

Lee discloses a networked device with multiple clients with access to the server and the data on that server. Anytime a client wants data from a server that client makes a request and the server responds to the request by sending the requested data. That is how client/server relationships work. Lee discloses that a client device make a request to the server, at which point the server is able to determine how to optimize or modify image data to be more useful to the client. The image data is optimized and sent to the client is response to a request from a client. This is interpreted to read on what is now claimed in independent claim 3 and other corresponding independent claims. The rejection is therefore maintained.

Claims 8 and 11-17

With regard to claims 8 and 11-17, Appellant makes the same arguments regarding the image data being previously generated and stored prior to receiving request data. The same response in the discussion above therefore applies. The rejection is maintained.

Claims 10, 18 and 19

With regard to claims 10, 18 and 19, Appellant makes the same arguments regarding the image data being previously generated and stored prior to receiving request data. The same response in the discussion above therefore applies. The rejection is maintained.

iv) *Claims 4-6*

Appellant states that claims 4-6 are allowable by virtue of their dependence on claim 3. Appellant has never challenged the merit of Examiner's Official Notice taken with regard to claims 4-6. Examiner will interpret this as Appellant agrees with the Official Notice taken and that Appellant only disagrees with the rejections of the independent claim 3.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Wes Tucker

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